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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,393	10/15/2003	John S. McPherson		4442

7590 12/14/2004
Gregory J. Gore
Suite 316
70 West Oakland Avenue
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EXAMINER

JUBA JR, JOHN

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,393

Applicant(s)

MCPHERSON ET AL.

Examiner

John Juba, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/04/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claims 1 – 17, 19 – 22, and 24 are objected to because of the following informalities. Appropriate correction is required:

Although the support arm recited in claim 1 inherently has a “support arm structure”, there is no express antecedent basis for “said support arm structure” recited in line 17. Thus, the claim could be even more clear in this respect. Claims 2 – 17, 18 – 22 and 24 are objected to as containing the same informality through their dependency from claim 1.

In claim 2, there is no antecedent basis for “said clamping plane.”

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1 – 20, 23, and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 8 and 10 – 21 (variously) of U.S. Patent No. 6,655,807 in view of Hoek (U.S. Patent number 5,903,402). The correspondence of claims is tabulated below:

<u>Pending claim number</u>	<u>Patented claim number</u>
1, 24	1
2	2
3	10
4	17
5	3
6	4
7	5
8	6
9	18
10	20
11, 12, 13, 14, 15, 16	11, 12, 13, 14, 15, 16 (respectively)
17	7
18, 23	21
19	8
20	19

Pending claims 1, 2, 3, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20 are slightly broader than patented claims 1, 2, 10, 3, 4, 5, 6, 18, 20, 11, 12, 13, 14, 15, 16, 7, 8, and 19 (respectively), by not reciting a clamping plane as being defined by the first and second jaws, by reciting that the first jaw engages a guide rail on “one edge” of the support arm, rather than particularly the “top edge”, and reciting that the second jaw

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engages a guide rail along a "second edge" of the support arm, rather than particularly the "bottom edge". Pending claim 24 then recites the clamping plane of patented claim 1. These differences are regarded as obvious differences, since the pending claims generically dominate these aspects of the patented claims, and since a structure that infringes these aspects of the patented claims necessarily infringes *these aspects* of the pending claims, but for the following difference. Each of these listed pending claims is *narrower* by reciting that the support arm is for attachment to a vehicle body particularly by a mirror mount, and by reciting that the support arm particularly comprises "first and second legs separated by a substantial void which extends along the support arm forming separated horizontal parallel segments". That is, the patented claims are more broadly directed to a support arm that may comprise a single horizontal "leg".

Still, in the same field of endeavor, Hoek discloses an adjustable mirror (Fig. 2) having a mirror head supported along a single telescoping support leg connecting the mirror head to a support base. Hoek teaches it may be desirable to replace a single telescoping support leg with a pair of "identical" telescoping supports, connecting the mirror head to a support base by separated horizontal parallel segments.

It would have been obvious to provide the support arm of the patented claims in the form of a pair of legs forming separated horizontal parallel segments, in the interest of providing an equivalently suitable telescoping support arrangement, as suggested by Hoek. It has been held that the mere duplication of structure does not represent a patentable advance. See for example *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1969). In the instant case, one of ordinary skill would have recognized that the

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provision of two spaced-apart arms would have provided greater stability against mirror oscillation in a vertical plane, and thus would have provided a more stable viewing surface and clearer viewed image.

Pending claim 4 differs from patented claim 17 in much the same way, but is also broader by not requiring the second jaw to include a V-shaped guide rail cooperating with a V-shaped support arm guide rail. These differences are regarded as obvious differences, since the pending claims generically dominate these aspects of the patented claims, and since a structure that infringes these aspects of the patented claims necessarily infringes *these aspects* of the pending claims, but for the following differences. Pending claim 4 is *narrower* by reciting that the support arm is for attachment to a vehicle body particularly by a mirror mount, and by reciting that the support arm particularly comprises "first and second legs separated by a substantial void which extends along the support arm forming separated horizontal parallel segments". That is, the patented claims are more broadly directed to a support arm that may comprise a single horizontal "leg". However, as set forth above, it is believed that Hoek fairly suggests the use of first and second legs as spaced horizontal segment such that this difference would have been obvious. Claim 4 is also narrower than patented claim 17 by reciting bearing means between the jaws and respective guide rails. However, those of ordinary skill knew that, where two surfaces are in sliding engagement, the service lifetime of the assembly can be extended by providing bearing means between the surfaces. Thus, since the jaws and rails of patented claim 17 are slidably engaged, one of ordinary skill would have found it obvious to include bearing

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means for the purposes of reducing wear and thus for the purpose of extending the useful life of the assemble, as was well known. Thus, it appears that the combination of claim 4 would have been obvious over patented claim 17 in light of common knowledge and the teachings of Hoek.

Pending claim 18 is *broader than* patented claim 21 by omission of the recitation that "said bracket is slidably affixed to said support arm on only one side thereof such that when said movable jaw is moved to a point of release, the jaws of said clamp means and said bracket are laterally releasable from the edges of said support arm." However, this difference is regarded as an obvious difference, since the pending claim generically dominates this aspect of the patented claim, and since a structure that infringes this aspect of the patented claims necessarily infringes *this aspect* of the pending claims, but for the difference discussed below. Claim 23 contains the missing recitation and differs from patented claim 21 only as follows. Pending claims 18 and 23 are *narrower* by reciting that the support arm has "two horizontally extending legs at one end" and that the mounting bracket is particularly affixed at the opposite end. That is, the patented claim is more broadly directed to a support arm that may comprise a single horizontal "leg". However, as set forth above, it is believed that Hoek fairly suggests the use of first and second legs as spaced horizontal segment such that this difference would have been obvious, at least for the purpose of providing greater stability against mirror oscillation in a vertical plane, and a more stable viewing surface with a clearer viewed image, as would be understood by the artisan as being achieved by the duplication of structure.

Allowable Subject Matter

Subject to the aforementioned double patenting rejection, claims 1 – 24 distinguish over the prior art, since the prior art, taken alone or in combination fails to disclose or fairly suggest *in combination*, a support arm, a bracket slidably cooperating with the support arm, and clamp means having first and second jaws cooperating with the support arm, *particularly wherein* at least one jaw is movable and

the first and second jaws engage first and second guide rails located along first and second edges the support arm, and the movable jaw includes pivot means, as recited in claim 1; or wherein

the two jaws engage top and bottom edges of the support arm, and the at least one movable jaw pivots and forceably engages a bearing surface along one of said support arm edges, as recited in claim 18.

For the reasons set forth above with respect to independent claim 1, claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest modification of the patented claims to include a pair of two-part telescoping covers with the particularity recited in claim 21.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Foote, et al (U.S. Patent number 6,439,730) disclose an extendable rearview mirror assembly comprising a support arm with two legs and a bracket slidably received on the legs (Fig. 8).


SPAFAX INTERNATIONAL Ltd (WO 92/03309 A1) disclose a clamp for slidably mounting an adjustable mirror bracket to a single vertical support column.

As a matter of course, all of the references cited during prosecution of parent application serial number 10/092,580 have been considered. These references are cited in Applicants' I.D.S. of February 4, 2004. See attached form PTO/SB/08A.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (571) 272-2314. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn whose number is (571) 272-2312 and who can be reached on Mon.- Thu., 9 - 5.

The centralized fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for *all* communications.


JOHN JUBA, JR.
PRIMARY EXAMINER
Art Unit 2872

December 10, 2004